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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,952	02/06/2004	Katja Peter	LWEP:122US	7353

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EXAMINER
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CONSILVIO, MARK J

ART UNIT	PAPER NUMBER
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2872

MAIL DATE	DELIVERY MODE
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01/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/773,952

Applicant(s)

PETER ET AL.

Examiner

Mark Consilvio

Art Unit

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 4-13 and 16-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3, 14, 15 and 31 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 06/25/2007.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

In view of the supplemental appeal brief filed on 11/30/2007, PROSECUTION IS  
HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following  
two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37  
CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an  
appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee  
can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have  
been increased since they were previously paid, then appellant must pay the difference between  
the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing  
below:

#### ***Status of Claims***

Claims 4-13 were withdrawn. Claims 1, 3, and 31 were previously rejected. Claims 2  
and 14-30 were indicated to contain allowable subject matter. Claims 1-31 are currently  
pending.

The indicated allowability of claims 2 and 14-30 is withdrawn in view of the newly  
discovered reference(s) to Kojima (US 5,703,714) and Sato (US 5,000,555). Rejections based on

the newly cited reference(s) follow. Accordingly, claims 16-30 are also withdrawn from consideration in light of the restriction requirement filed 07/11/2005 since these claims no longer depend from an allowable linking claim.

***Information Disclosure Statement***

The information disclosure statement (IDS) submitted on 06/25/2007 is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 1 is rejected under 35 U.S.C. 102(b) as being anticipated by Abe (US Patent No. 6,235,014).

Abe discloses a device for controlling microscope functions including a display (3) integrated into a stand base portion, wherein the display can be used to perform settings of the microscope, call saved settings, and display warnings or notifications from the system (see also figs. 1-3).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Abe (US Patent No. 6,235,014).

With respect to claim 3, Abe does not disclose the display to display main, sub-main, and submenus. However, this type of “nested” menu structure is very well known in the prior art and commonly used in display systems. See, e.g., Kojima (US Patent No. 5,703,714) or Lane et al. (US Patent No. 5,704,051). At the time of the invention, it would have been obvious to use such a menu structure including these types of menus in Abe’s system in order to organize the information and control systems, thus making them easy to use.

With respect to claim 31, Abe does not specifically teach the display to control either objective selection or magnification selection. However, Abe discloses both of these functions in relation to the microscope and it is well known in the prior art to control these functions via a display. See, e.g., Kojima (US Patent No. 5,703,714). At the time of the invention, it would have been obvious to the ordinarily skilled artisan at the time of invention to use Abe’s display/control to control either or both of these functions in order to provide the user with convenient location of all of the controls of the system, thus making the system more efficient to use and compact.

Claims 1-3, 14, 15, and 31 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Kojima (US Patent No. 5,703,714) in view of Sato (US Patent No. 5,000,555).

With respect to claim 1, Kojima discloses a device for controlling microscope functions of a microscope within a microscope system, said device comprising: a stand base portion (not shown), a central display (101, 102) integrated into a stand base portion (i.e. whatever element supports the display), wherein the central display can be used to perform a plurality of settings of the microscope within the microscope system (i.e. magnification selection, observation method selection, etc...), to call saved settings of the microscope within the microscope system (e.g. see col. 6, lines 56-63) and to receive warning messages or notifications from the microscope within the microscope system (e.g. see fig. 26) (see also figs. 1-15).

The previous rejection of claim 1 by Kojima is appropriate under 35 U.S.C. 102(b). However, if a more narrow reading of the limitation of *a central display integrated into a stand base portion* is taken (i.e. the display is located in the base of the stand supporting the optical elements of the microscope), then Kojima does not expressly disclose a central display integrated into a stand base portion (though clearly the optical elements of Kojima must have a housing to support the optical elements including a stand base portion). However, Sato discloses a microscope having a central display (41) integrated into a stand base portion (1a) of the microscope (fig. 4B). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to integrate the display of Kojima into the stand base portion of Kojima to achieve the claimed invention because all the claimed elements were known in the

prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination yielded predictable results. *KSR*, 550 U.S. at \_\_\_, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson 's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950).

With respect to claims 2 and 14, Kojima discloses, in addition to the features of claim 1, the display contains an operating menu and an information mode, the operating menu being constructed from a first region (330), a second region (310), and a third region (320), and a main menu being displayable in the first region, a submenu in the second region, and information and action elements (321, 322) in the third region, the third region being delimited on one side by the main menu and on one side by the submenu, and the entire display being usable for presentation in the information mode (fig. 10).

With respect to claims 3 and 15, Kojima discloses a main menu (e.g. fig. 10) is constructed from multiple sub-main menus (300, 310, 320, etc...); and depending on the selection of the sub-main menu (i.e. 300) by the user, a respective submenu (e.g. fig. 11) corresponding to the selected sub-main menu is displayable on the display.

With respect to claim 31, Kojima discloses the plurality of settings that can be performed includes at least one of objective selection and secondary magnification selection (abstract).

***Response to Arguments***

Applicant's arguments filed 11/30/2007 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to teach or suggest certain claimed limitations, it is noted that the limitation(s) upon which applicant relies (i.e., *a plurality of settings of the microscope within a microscope system*) must be given their broadest reasonable construction as would be interpreted by one of ordinary skill in the art. *Phillips v. AWH Corp.*, 415 F.3d 1303, 75 USPQ2d 1321 (Fed. Cir. 2005). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969). See MPEP § 2111 - § 2116.01, for additional case law relevant to claim interpretation. It appears that the applicant's position is that the setting of the laser in the Abe reference cannot be considered a setting of the microscope within the microscope system. However, no delineation of where the microscope ends and microscope system begins is provided in the claims. While one of ordinary skill will recognize the primary function of a microscope is to observe objects or features that generally cannot be seen with the unaided eye, one would also recognize that a number of peripheral devices (optical or non-optical) may be included as part of the microscope. This includes illumination devices like the one taught by Abe. Therefore, under the "*broadest reasonable interpretation*" standard, the laser of Abe and its controls may be considered part of the microscope within a larger microscope system.



In response to applicant's argument that the examiner has not addressed the "unique use" of the invention of claim 3, the fact that applicant has recognized advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). The menu system limited by the claim does not appear to provide any "unique" function at all. Not only is there a wealth of prior menu systems (e.g. ticket kiosks, ATM machines, etc...) outside the microscope art that would be applicable, but many microscope control systems have display screens that contain similar menu systems.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning regarding claim 31, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Consilvio whose telephone number is (571) 272-2453. The examiner can normally be reached on Monday thru Thursday, 8:30 am to 6:00 pm.

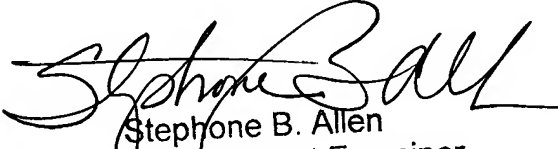
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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MC  
1/18/2008

  
Stephone B. Allen  
Supervisory Patent Examiner